



08 AUG 2003

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In re Application of
BAMBERG et al.
Application No. 09/980,466
PCT No.: PCT/IB99/00976
Int. Filing Date: 01 June 1999
Priority Date: None
Attorney Docket No.: P00619-US
For: INK-JET TRANSFER SYSTEM FOR
DARK TEXTILE SUBSTRATES

DECISION ON PETITION
UNDER 37 CFR 1.47(b)

This is a decision on applicant's "Petition under 37 C.F.R. 1.47(b)" filed 05 August 2002 to accept the application without the signature of inventors Ulf Bamberg, Ilona Stiburek, and Peter Kummer.

BACKGROUND

On 01 June 1999, applicant filed international application PCT/IB99/00976. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 December 2000. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the international filing date. Accordingly, the thirty-month time period for submitting the requisite basic national fee in the United States of America was extended to expire 30 months from the international filing date, 01 December 2001.

On 30 November 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of international application; and a preliminary amendment.

On 31 January 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed. The notification set a two-month time limit in which to respond.

On 05 August 2002, applicant filed the present petition under 37 CFR 1.47(b) and a petition and requisite fee for a four-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1) and (6). However, items (1), (3), (4) and (5) have not been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

a. Inventor Ulf Bamberg

Petitioner asserts that Ulf Bamberg cannot be found or located. A review of the present petition reveals that petitioner has not shown that a "diligent effort" was made to locate the missing inventor. Petitioner has provided a copy of the letter and a copy of envelope sent to Ulf Bamberg, however, these documents have not been translated into English. Additionally, petitioner has failed to state whether any other attempts were made to locate Ulf Bamberg. The single mailing of the papers to the nonsigning inventor's last known address does not constitute a "diligent" effort. Furthermore, it does not appear that the petitioner has first hand knowledge of all the facts.

b. Inventor Ilona Stiburek

Petitioner asserts that Ilona Stiburek has refused to execute the application. A review of the present petition reveals that petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, and drawings) to Ilona Stiburek. Petitioner states that "Mr. Paul Ronchi sent an envelope containing a cover letter dated January 17, 2002 and Declaration to the last known address of Mrs. Stiburek." The mailing of a cover letter and declaration are not considered a complete copy of the instant application (specification, including claims, drawings, and oath or declaration). Additionally, petitioner has provided a copy of the envelope and letter to Ilona Stiburek, however, these documents have not been translated into English. Furthermore, it does not appear that the petitioner has first hand knowledge of all the facts. As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Ilona Stiburek, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

c. Inventor Peter Kummer

Petitioner asserts that Peter Kummer has refused to execute the application. A review of the present petition reveals that petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, and drawings) to Peter Kummer. Petitioner states, "Mr. Paul Ronchi sent an envelope containing a cover letter and Declaration to Mr. Kummer" and that Mr. Kummer would not execute the Declaration. The mailing of a cover letter and declaration is not considered a complete copy of the instant application (specification, including claims, drawings, and oath or declaration). As stated

above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Peter Kummer, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. Furthermore, it does not appear that the petitioner has first hand knowledge of all the facts.

Concerning Item (3), a statement of the last known address of the nonsigning inventor(s) has not been provided.

Regarding Item (4), an acceptable oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has not been provided. The declaration provided with the present petition has been executed by the attorney of record, Daniel W. Sullivan, however, the petition papers do not aver that Mr. Sullivan has authority to execute the declaration. Therefore, the declaration provided is not acceptable. (See Section 409.03(b) of M.P.E.P.)

Concerning Item (5), section 409.03(f) of the M.P.E.P., **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Regarding item (5), petitioner has not demonstrated that applicant has a propriety interest in the invention. Petitioner has provided a copy of an employment agreement and Regulations for Employees of Oce (Schwiez) AG. However, the petition papers do not indicate firsthand knowledge of the specific details surrounding the present invention of Ulf Bamberg, Ilona Stiburek, and Peter Kummer, including the specific relationship of the inventive activities of Ulf Bamberg, Ilona Stiburek, and Peter Kummer and their employment with Oce (Schwiez) AG. As stated in section 409.03(f) of the M.P.E.P. when such an employment agreement is relied upon, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant. An affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed has not been provided.

For the reasons stated above, it would not be appropriate to accept the application without the signatures of Ulf Bamberg, Ilona Stiburek, and Peter Kummer under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition filed under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO MONTHS from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450,
Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the
Office of PCT Legal Administration.



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